

REMARKS

Foreign Priority:

Applicant notes that Applicant claimed foreign priority and filed a certified copy of the Foreign Priority Document 2000-076903 with the present application on March 15, 2001. Therefore, Applicant hereby requests the Examiner acknowledge Applicant's claim to foreign priority and that the certified copy of the priority document has been received.

Information Disclosure Statement:

Applicant thanks the Examiner for initialing and returning the Form PTO-1449 filed on August 21, 2002, thus indicating that all of the references listed thereon have been considered.

Applicant notes that Applicant also filed an Information Disclosure Statement dated September 11, 2001 (received in the USPTO and acknowledged on September 12, 2001) listing, among other references, U.S. Patent No. 5,754,160 to Shimizu et al. Applicant notes that in the initialed copy of the Form PTO-1449 filed on September 12, 2001, returned by the Examiner with the above referenced Office Action, the Shimizu reference was not initialed. However, Applicant further notes that Shimizu was referenced by the Examiner in the rejection of claim 2 (see page 3 of the above Office Action), and was thus considered by the Examiner.

Therefore, Applicant hereby respectfully requests the Examiner initial the listing of the Shimizu reference on the subject Form PTO-1449, thus ensuring that the Shimizu reference has been considered and appears on the face of any patent resulting from the above referenced application.

Claim Amendments:

Applicant notes that claims 1 and 3 have been amended as shown in the attached Appendix to clarify the claimed invention. Applicant notes that the amendments to claims 1 and 3 are not intended to narrow the scope or spirit of the original claims in any way.

Claim Rejections:

Claims 1-5 are all the claims pending in the application, and currently all of the claims stand rejected.

35 U.S.C. § 103(a) Rejection - Claims 1 and 3-5:

Claims 1 and 3-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,356,251 to Naito et al. in view of U.S. Patent No. 5,892,504 to Knapp. In view of the following discussion, Applicant respectfully disagrees.

As an initial matter, Applicant notes that claim 3 depends on claim 2, and that the Examiner has admitted that neither of the Naito or Knapp references, either individually or in combination, discloses the claimed invention as set forth in claim 2. *See* Office Action, page 3. Therefore, Applicant respectfully requests the Examiner reconsider and withdraw the above 35 U.S.C. § 103(a) rejection of claim 3.

Turning now to claim 1, as shown in Figure 1, of Naito, this reference discloses having both scan electrodes and signal electrodes crossing each other at points on a substrate **10**, where each of the rows of scan electrodes and columns of signal electrodes are driven, respectively, by a scan electrode driving system **40** and a signal electrode driving system **50**. *See* Figures 1-4 and 12, and corresponding discussions within Naito. Further, Naito appears to disclose that the

driving systems **40**, **50** control more than two scanning electrodes simultaneously while successively lighting their corresponding horizontal regions. *See* Figures 24-25 and 27, and their corresponding discussion.

However, as the Examiner admits, there is no disclosure, of any kind, in Naito that the signal electrode driving circuit **50** (i.e. the column driving circuit) controls the current in the signal (i.e. data) electrodes so that the current density in the light emitting elements are maintained constant.

For this feature of the claimed invention, the Examiner erroneously relies on the Knapp reference. The Examiner asserts that because Knapp teaches to apply a predetermined and fixed voltage to column address conductors, rather than actual display data voltages, at selected periods, based on data from a sensing circuit **40**, it would have been obvious to combine this feature of Knapp with the teachings of Naito. *See* Knapp, Figure 4, and col. 4, lines 56-60 and col. 5, lines 21-37. Applicant respectfully disagrees with the Examiner.

Applicant submits that Knapp merely teaches using an image display driving device and a sensing circuit for controlling the brightness of the light emitting elements. Applicant notes that there is no express or implicit teaching or suggestion, in Knapp, that the control circuit is used to maintain current density at a constant level, as recited in claim 1. Thus, for at least this reason, Applicant notes that even if the above references were combined, they fail to disclose, teach or suggest each and every feature of the claimed invention.

However, additionally and independently, Applicant notes that the above cited references fail to provide the necessary motivation or suggestion to be combined as asserted by the

Examiner. Thus, even if the references together disclosed each and every feature of the claimed invention (which is not Applicant's position as set forth above), one of ordinary skill in the art would not have been motivated to combine these references at the time of the present invention. Specifically, Applicant notes that neither of the cited references teach or suggest the desirability of the above combination, or the mere fact that they can be combined. Applicant notes that the mere fact that a reference can be modified does not make the resultant modification unless the prior art also suggests the desirability of the modifications. See *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Further, it is noted that the mere fact that the claimed invention is within the capabilities or familiarities of one of ordinary skill in the art is not sufficient, by itself, to establish *prima facie* obviousness. See MPEP § 2143.01.

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See *In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." *Kotzab*, 55 USPQ2d at 1316 (quoting *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. *In re Kotzab*, 55 USPQ2d at 1316 (citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir.

1998). Thus, every element of a claimed invention may often be found in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *Id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *In re Kotzab*, 55 USPQ2d at 1316 (citing *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); and *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)).

“Although the suggestion to combine references may flow from the nature of the problem, ‘defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness.’” *Exolochem, Inc. v. Southern California Edison Co.*, 2000 U.S. App. LEXIS 22681, *28 (Fed. Cir. 2000) (citing *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 880, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998)). “Therefore, when determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus obviousness, of making the combination.” *Id.* at *29-30 (citing *In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992)). As discussed and set forth above, Applicant submits that there is no such suggestion (or motivation) of the desirability to combine the above references.

Therefore, in view of the above discussions, and the fact that even if the cited references were combined they fail to disclose each and every feature of the claimed invention, Applicant

submits that the Examiner has failed to establish a *prima facie* case of obviousness, and hereby requests the Examiner reconsider and withdraw the above 35 U.S.C. § 103(a) rejection of claim

1. Further, as claims 3-5 depend on claim 1, Applicant submits that these claims are also allowable, at least by reason of their dependence.

35 U.S.C. § 103(a) Rejection - Claim 2:

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Naito in view Knapp, and in further view of U.S. Patent No. 5,754,160 to Shimizu. However, since claim 2 depends on claim 1, and because Shimizu fails to cure the deficient teachings of Naito and Knapp with regard to claim 1, Applicant respectfully submits that claim 2 is in allowable condition, at least by reason of its dependence.

Conclusion:

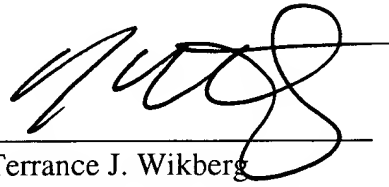
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/808,040

Our Ref.: Q63295
Art Unit: 2674

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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PATENT TRADEMARK OFFICE

Date: January 23, 2003

APPENDIX
VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claims are amended as follows:

1. (Amended) An electroluminescent (EL) image display device which comprises a plurality of stripe-like data electrodes, a light emitting layer, and a plurality of stripe-like scanning electrodes formed on a substrate in sequence, and further comprises an image display portion formed by a plurality of light emitting elements in a matrix form at crossing points between said data electrodes and said scanning electrodes, and a column driving circuit and a row driving circuit for driving said image display portion by selecting and lighting said light emitting elements: wherein,

said row driving circuit ~~has a function to~~ simultaneously drives more than two of said scanning electrodes and successively lighting ~~the~~ horizontal regions in sequence corresponding to the number of scanning electrodes for simultaneously driving said light emitting elements; and

said column driving circuit ~~has a function to~~ controls a current flowing in said data electrodes such that a current density of said light emitting element is maintained ~~without changing~~ constant.